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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,716	03/30/2001	Thomas M. Sirhall	SMQ-058	7464

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EXAMINER

YIGDALL, MICHAEL J

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 03/25/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/823,716

Applicant(s)

SIRHALL, THOMAS M.

Examiner

Michael J. Yigdal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-24 are pending and have been examined. The priority date considered for the application is 30 March 2001.

#### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/825,379.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both recite systems and methods for online instructional testing in which a user selects answers to questions by interacting with a graphical user interface.

For example, claim 1 in both applications recites sending a software tool to a client, displaying a question and a list of answers, and a user selecting at least one answer. Claim 2 in both applications recites providing feedback to the user in response to the selected answer. Claims 3 and 5 in the present application are analogous to claim 3 in the conflicting application. Present claim 6 and conflicting claim 4 both recite that some or all of the invention is implemented as an applet.

Moreover, claim 13 in the present application and claim 8 in the conflicting application both recite a medium having instructions for displaying questions and answers and allowing a user to select at least one answer. Claims 16, 17 and 18 in the present application are analogous to claims 12, 13 and 14 in the conflicting application, respectively, in that both recite referencing the software tool or applet in HTML code, including the questions in the HTML code, and using separate definition or input files to prevent the user from obtaining the correct answer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/825,536.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both recite systems and methods for online instructional testing in which a user selects answers to questions by interacting with a graphical user interface.

For example, claim 1 in both applications recites sending a software tool to a client, displaying a question and a list of answers, and a user selecting at least one answer. Claim 2 in both applications recites providing feedback to the user in response to the selected answer. Claims 3 and 5 in the present application are analogous to claim 3 in the conflicting application. Present claim 6 and conflicting claim 4 both recite that some or all of the invention is implemented as an applet.

Moreover, claim 13 in the present application and claim 8 in the conflicting application both recite a medium having instructions for displaying questions and answers and allowing a user to select at least one answer. Claims 16, 17 and 18 in the present application are analogous to claims 12, 13 and 14 in the conflicting application, respectively, in that both recite referencing the software tool or applet in HTML code, including the questions in the HTML code, and using separate definition or input files to prevent the user from obtaining the correct answer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Objections***

5. Claim 24 is objected to because of the following informalities: The claim further limits “the computer-readable medium of claim 20,” but claim 20 does not expressly recite a computer-readable medium. The claim was perhaps intended to read --the electronic device of claim 20-- or --the memory of claim 20--. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. No. 6,112,049 to Sonnenfeld.

With respect to claim 1, Sonnenfeld discloses, in an electronic device that provides an on-line educational course (see the title and abstract, and column 8, lines 61-67, which shows providing academic instruction using the Internet), a method comprising:

(a) providing an interactive list software tool, wherein the software tool generates a graphical user interface displaying a question and an answer box to a user to select at least one answer to the question in the answer box (see column 4, lines 37-44, which shows providing questions and interactively gathering responses, and lines 63-66, which further shows that the presentation, i.e. the graphical user interface, is automated or generated; see also column 5, lines 37-45, which shows that the multiple choice questions allow the user to select one or more, i.e. at least one, answer, and column 13, lines 53-63, which further shows that the fields may be in the form of list boxes); and

(b) forwarding the list software tool from the electronic device to a remote client (see column 10, lines 28-41, which shows forwarding the data from the host device to a client).

With respect to claim 2, Sonnenfeld further discloses the limitation wherein the list software tool provides feedback to the user indicating whether an answer selected by the user is correct (see column 9, lines 41-44 and 60-61, which show examples of feedback provided to users based on the selected answers).

With respect to claim 3, Sonnenfeld further discloses the limitation wherein the list software tool permits a predetermined number of attempts by the user to enter a correct answer (see column 10, lines 21-23, which shows predetermining the number of attempts the user is permitted).

With respect to claim 4, Sonnenfeld further discloses the limitation wherein the list software tool automatically provides a correct answer in the answer box after the user surpasses the predetermined number of attempts (see column 6, lines 24-25, which shows providing correct answers upon completion, i.e. when the user has responded to the questions or is no longer permitted to do so).

With respect to claim 5, Sonnenfeld further discloses the limitation wherein the list software tool prevents the user from entering an answer after the predetermined number of attempts (see column 10, lines 19-27, which shows implementing security features, including limiting the number of attempts the user is permitted; note that the user is inherently prevented from answering the questions when the limit is reached).

With respect to claim 6, Sonnenfeld further discloses the limitation wherein the list software tool is an applet (see column 3, lines 12-20, which shows that parts of the system may comprise applets).

With respect to claim 7, Sonnenfeld discloses, in an electronic device that provides an on-line educational course (see the title and abstract, and column 8, lines 61-67, which shows providing academic instruction using the Internet), a method comprising:

(a) receiving a request for a Web page at the electronic device from a remote client (see column 12, line 56 to column 13, line 7, which shows a host device receiving requests from a client in a Web-based system); and

(b) in response to the receiving step, sending a Web page containing a question and a list software tool embedded therein to the remote client, wherein the list software tool generates a graphical user interface (GUI) including instructions to a user to enter an answer to the question provided by the Web page (see column 11, lines 46-57, which shows sending an HTML document, i.e. a Web page, to the client comprising test questions; see also column 4, lines 37-44, which shows providing questions and interactively gathering responses, and lines 63-66, which further shows that the presentation, i.e. the graphical user interface, is automated or generated; see also column 16, lines 37-49, which shows providing instructions for responding to or answering the questions).

With respect to claim 8, Sonnenfeld further discloses the limitation wherein the Web page comprises a page of an on-line educational course (see column 8, lines 61-67, which shows that the test is part of an Internet instruction course).



With respect to claim 9, Sonnenfeld further discloses the limitation wherein the Web page includes a software tool tag instructing a browser to execute instructions for running the list software tool (see column 2, lines 46-60, which shows that the system may be defined using HTML, and column 3, lines 12-20, which shows that parts of the system may comprise applets and plug-ins; note that software tool tags are inherently used in HTML to implement such plug-ins and applets).

With respect to claim 10, Sonnenfeld further discloses the limitation wherein the list software tool includes a definition file defining a correct answer to the question (see column 4, lines 52-59, which shows that the system includes a database, i.e. a definition file, for storing information about the questions, such as the correct answers).

With respect to claim 11, Sonnenfeld further discloses the limitation wherein the definition file is separate from a source code for the Web page to prevent a user from obtaining the correct answer by viewing the source code (see column 4, lines 14-25, which shows using external references in the database; see also column 10, lines 19-27, which shows implementing security features to prevent unauthorized access and tampering).

With respect to claim 12, Sonnenfeld further discloses the limitation wherein the list software tool is an applet (see column 3, lines 12-20, which shows that parts of the system may comprise applets).

With respect to claim 13, Sonnenfeld discloses a computer-readable medium for use in an electronic device that provides an on-line educational course (see the title and abstract, and

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column 8, lines 61-67, which shows providing academic instruction using the Internet), comprising instructions for running a list software tool for displaying a question and an answer box to a user, wherein the user can select at least one answer in the answer box to the question (see column 4, lines 37-44, which shows providing questions and interactively gathering responses; see also column 5, lines 37-45, which shows that the multiple choice questions allow the user to select one or more, i.e. at least one, answer).

With respect to claim 14, Sonnenfeld further discloses the limitation wherein the instructions are executable on a virtual machine (see column 3, lines 12-20, which shows that parts of the system may comprise Java applets, which are executable on a virtual machine).

With respect to claim 15, Sonnenfeld further discloses the limitation wherein the instructions are stored on a server and downloaded to a local processor of the user (see column 10, lines 28-41, which shows downloading the data from the host server to a local user terminal).

With respect to claim 16, Sonnenfeld further discloses the limitation wherein the medium includes hypertext markup language (HTML) code to reference the software tool (see column 2, lines 46-60, which shows that the system may be referenced using HTML).

With respect to claim 17, Sonnenfeld further discloses the limitation wherein the HTML code includes the question (see column 11, lines 46-57, which shows formulating the test questions using HTML code).

With respect to claim 18, Sonnenfeld further discloses a definition file indicating a correct answer for the question, the definition file being separate from the HTML code to prevent

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the user from obtaining the correct answer by looking at the HTML code (see column 4, lines 52-59, which shows that the system includes a database, i.e. a definition file, for storing information about the questions, such as the correct answers; see also column 4, lines 14-25, which shows using external references in the database; see also column 10, lines 19-27, which shows implementing security features to prevent unauthorized access and tampering).

With respect to claim 19, Sonnenfeld further discloses the limitation wherein the list software tool is an applet (see column 3, lines 12-20, which shows that parts of the system may comprise applets).

With respect to claim 20, Sonnenfeld discloses an electronic device for providing an on-line educational course (see the title and abstract, and column 8, lines 61-67, which shows providing academic instruction using the Internet) comprising:

- (a) a processor (see terminals 3 and 4 in FIG. 1, which inherently comprise processors);
- (b) a display screen (see terminals 3 and 4 in FIG. 1, which inherently comprise display screens); and
- (c) memory including a Web page having an interactive list software tool embedded therein (see column 11, lines 46-57, which shows an HTML document, i.e. a Web page, with the test questions embedded therein),

wherein the processor executes the list software tool to generate a graphical user interface on the display screen, the graphical user interface displaying a question, and an answer box to a user to select at least one answer from the answer box to the question (see column 4, lines 37-44, which shows providing questions and interactively gathering responses, and lines 63-66, which

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further shows that the presentation, i.e. the graphical user interface, is automated or generated; see also column 5, lines 37-45, which shows that the multiple choice questions allow the user to select one or more, i.e. at least one, answer).

With respect to claim 21, Sonnenfeld further discloses a browser for locating and displaying the Web page (see column 12, lines 56-65, which shows a Web browser).

With respect to claim 22, Sonnenfeld further discloses a network connection for connecting the electronic device to a computer network (see network 2 in FIG. 1 and column 12, line 66 to column 13, line 7).

With respect to claim 23, Sonnenfeld further discloses input media to allow the user to enter the answer (see column 10, lines 28-41, which shows input from the user to enter responses or answers).

With respect to claim 24, Sonnenfeld further discloses the limitation wherein the list software tool is an applet (see column 3, lines 12-20, which shows that parts of the system may comprise applets).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Pat. No. 6,431,875 to Elliott et al. discloses a method for developing and administering tests over a network. U.S. Pat. No. 6,498,920 to Simon discloses a customizable Web-based training system.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (703) 305-0352. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MY

Michael J. Yigdall  
Examiner  
Art Unit 2122

mjy  
March 18, 2004



**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**